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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/254,743 05/28/99 WEBER

QM02/0814

J GEORG SEKA  
TOWNSEND AND TOWNSEND AND CREW  
TWO EMBARCADERO CENTER  
8TH FLOOR  
SAN FRANCISCO CA 94111

EXAMINER	
R	88724
ART UNIT	PAPER NUMBER

ATKINSON, C  
DATE MAILED:

3743

08/14/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/254,743

Applicant(s)

Weber et al.

Examiner

Atkinson

Group Art Unit

3743

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 7/24/2000
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-11 and 17-33 is/are pending in the application.
- Of the above claim(s) 17-26 and 31-33 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-11 and 27-30 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 4
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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***Response to Election***

Applicant's election of species A as illustrated in Figure 1 in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 17-26 and 31-33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 9.

Claims 1-11 and 17-33 are pending.

***Specification***

Applicant is advised on how to arrange the content of the specification.

**Content of Specification**

- (a) Title of the Invention: See 37 CFR 1.72(a). The title of the invention should be placed at the top of the first page of the specification. It should be brief but technically accurate and descriptive, preferably from two to seven words.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) Reference to a "Microfiche Appendix": See 37CFR 1.96(c) and MPEP § 608.05. The total number of microfiche and the total number frames should be specified.
- (e) Background of the Invention: The specification should set forth the Background of the Invention in two parts:

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- (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
- (2) Description of the Related Art: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (f) Brief Summary of the Invention: A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (g) Brief Description of the Several Views of the Drawing(s): A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. This item may also be titled "Best Mode for Carrying Out the Invention." Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (I) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet. (37 CFR 1.52(b)). Where a claim sets forth a

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plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps.

- (j) Abstract of the Disclosure: A brief narrative of the disclosure as a whole in a single paragraph of 250 words or less on a separate sheet following the claims.
- (k) Drawings: See 37 CFR 1.81, 1.83-1.85, and MPEP § 608.02.
- (l) Sequence Listing: See 37 CFR 1.821-1.825.

The spacing of the lines of the specification is such as to make reading and entry of amendments difficult. New application papers with lines double spaced on good quality paper are required.

#### ***Claim Objections***

The claims are objected to because the lines are crowded too closely together, making reading and entry of amendments difficult. Substitute claims with lines one and one-half or double spaced on good quality paper are required. See 37 CFR 1.52(b).

Claims 3 and 28-30 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

#### ***Claim Rejections - 35 USC § 112***

Claims 1-11 and 27-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. The claims are replete with errors. In claim 1 for example, the recitations "the cooling tubes" and "the form" lack antecedence; the phrases "such as", "for example", "attachable", "optionally", etc. render the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention or not, and the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.; the terms "means of a carrying system" are used to modify the word "means", thus purporting to conform to 35 USC 112, sixth paragraph. However, 35 USC 112, sixth paragraph, requires that the term(s) specify a function to be performed, thus enabling a determination of the structural equivalent thereof. For example, expressions such as "latch means" or "means for latching" have functional connotations and are in conformity with the statute. However, in this case, the terms have no functional connotations. See *Ex parte Klumb*, 159 USPQ 694. Also, for example, in claims 2, 28, etc. the recitation "premanufactured elements" is indefinite since these "elements" as designated by its reference numerals are elements which have previously been recited. In view of the plurality of errors, the Examiner has only given a few examples of the errors and applicant is required to correct all claim errors.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

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art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Claims 1-4, 6-11 and 27-30 are rejected under 35 U.S.C. § 103 as being unpatentable over Fischer in view of Herbst and Musgrave et al. The document of Fischer in the illustration discloses all the claimed features of the invention with the exception of the tubes being mats, the spacer being a plurality of spacers, a sound insulating fleece or holes and a carrying system. The claimed dimensions are considered to be obvious dimensions dependent upon the heating/cooling requirement and size of the room/building which does not solve any stated problem or produce any new and/or unexpected result.

The patent of Herbst in Figures 1-5 discloses that it is known to have a sound insulating (i.e. material and holes) ceiling carrying system and cooling tube mats in a plurality of ceiling panels for the purpose of reducing room noise, supporting the ceiling panels and for easy installation and repair. It would have been obvious at the time the invention was made to a

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person having ordinary skill in the art to employ in Fischer a sound insulating (i.e. material and holes) ceiling carrying system and cooling tube mats in a plurality of ceiling panels for the purpose of reducing room noise, supporting the ceiling panels and for easy installing and repair as disclosed in Herbst. The sound reducing material being fleece is considered to be an obvious and well known sound reducing material in view of the sound reducing material disclosed in Herbst which does not solve any stated problem or produce any new and/or unexpected result.

The patent of Musgrave et al. in Figure 2 disclose that it is known to have a plurality of spacers for the purpose of reducing the amount of material and weight relative to a single spacer which spaces ceiling plates apart. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ in Fischer as modified, the spacers being a plurality of spacers for the purpose of reducing the amount of material and weight relative to a single spacer which spaces ceiling plates apart as disclosed in Musgrave et al.

Claim 5 is rejected under 35 U.S.C. § 103 as being unpatentable over Fischer in view of Herbst and Musgrave et al. as applied to claims 1-4, 6-11 and 27-30 above, and further in view of Ingram. The document of Fischer as modified, discloses all the claimed features of the invention with the exception of the cooling tubes not in every panel.

The document of Ingram in Figures 11 and 13 discloses that it is known not to have the cooling tubes in every cooling panel for the purpose of reducing the cost of installing the cooling system. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ in Fischer as modified, not to have the cooling tubes in every



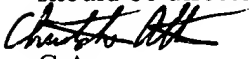
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cooling panel for the purpose of reducing the cost of installing the cooling system as disclosed in Ingram.

*Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Atkinson whose telephone number is (703) 308-2603.



C.A.

August 10, 2000

**CHRISTOPHER ATKINSON**  
**PRIMARY EXAMINER**